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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,261	03/07/2001	David McElroy	950.044US1	5526

7590

04/23/2003

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 04/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

07/501,261

Applicant(s)

McElroy et al

Examiner

FOX

Group Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/5/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 5-2-65 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 5-2-65 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicants' amendments and arguments of 5 February 2003 have overcome the objection to the specification and all rejections of record, except as indicated below.

Claims 52-65 (newly submitted) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-10 (prior to renumbering) of copending allowed Application No. 09/521,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons presented in the last Office action on page 3 for claims 2, 8-21 and 28-29.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 52-53 and 58 (newly submitted) are rejected under 35 U.S.C. 102(b) as being anticipated by each of Assaad et al and Swoboda et al (1994), as stated on pages 6-7 of the last Office action for claims 2, 8-13, 15, 19, 21 and 28.

Claims 54-57 and 59-65 are deemed free of the prior art, given the failure of the prior art to teach or suggest a method for deleting the particularly claimed marker genes in the particularly claimed host plant species at the particularly claimed frequencies.

No claim is allowed.

Applicant's arguments filed 5 February 2003, insofar as they pertain to the rejections above, have been fully considered but they are not persuasive.

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Applicants urge that the obviousness-type double patenting rejection is improper, given the failure of the instant claims drawn to marker gene deletion in any plant to be rendered obvious by the claims of the copending application which are limited to cereals and which encompass any type of transgene alteration. The Examiner maintains that the claims of the two applications are coextensive. Deletion of the marker gene, as recited in new claim 52 in the instant application, is claimed in claim 10 of the copending application. A selectable or reporter gene as claimed in instant claim 53 is claimed in claim 2 of the copending application. The particular markers of instant claim 54 are claimed in claim 3 of the copending application. Instant claims 56-57, drawn to particular cereal species, correspond to copending claims 7-8. Instant claims 60-62, drawn to maize and particular types of crossing schemes, correspond to copending claims 4-6 and 9.

Applicants urge that the art rejections above are improper, given the failure of the references to teach a "marker-free" transgenic plant, since a selectable marker gene remains in the transgenic plants taught by each reference, following recombination between fragments of selectable marker genes which are directly repeated. The Examiner maintains that each reference teaches the deletion of "a" pre-selected marker gene following recombination between flanking directly repeated sequences, as claimed. The resultant plant is "free" of the preselected intact marker gene which was present prior to recombination. The claims do not exclude the use of marker gene fragments to constitute the directly repeated sequences flanking the gene to be deleted. If basis for such a recitation can be found in the specification, or if the specification contains other language which characterizes the repeating sequences in a way which distinguishes

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them from fragments of selectable marker genes, Applicants are invited to amend the claims accordingly and to point out the basis for such amendments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April 21, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1807 1638

Accepted